



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/137,822	08/21/98	NAESBY	P1614-8067

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EXAMINER

ENEWOLD, J

ART UNIT	PAPER NUMBER
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1655

DATE MAILED: 07/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.

09/137,822

Applicant(s)

NAESBY, MICHAEL

Examiner

Jeanine A Enewold

Art Unit

1655

—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED 28 June 2000 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either a timely filed amendment which places the application in condition for allowance or a Notice of Appeal. Alternatively, applicant may obtain further examination by timely filling a request for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d).

PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136 (a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked.

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (see NOTE below);
- (b) ☐ they raise the issue of new matter. (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached sheet.

4. ☐ Applicant's reply has overcome the following rejection(s): _____.
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: NONE
- Claim(s) objected to: NONE
- Claim(s) rejected: 86-137.
- Claim(s) withdrawn from consideration: _____.
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
11. ☐ Other:

The amendment has not been entered because new grounds of rejection would be raised. Specifically, the addition of "nucleic acid A binding probe C comprises one or more parts" would be indefinite on the basis, that "parts" is unclear. Parts may mean the two ends of probe C namely the 5' and 3' parts, other diagnostic parts of the probe, or finally, two distinct probes C which are different in base sequence.

In the event that the amendment was not entered the response asserts that the term "aggregate" is not new matter. The response states that "aggregate" was intended to indicate that molecule C could be more than one part. However, as previously stated, the definition as found in the Stedman's dictionary is to unite or come together in a mass or cluster. The response also states that the term "aggregate" may mean "more than one unit taken as a whole". As evidenced by the two distinct definitions, the term aggregate is unclear. Furthermore, while the exact language is not required in the original specification, the meaning and use of aggregate in the claims has not been supported. Thus, the new matter and the 112 second paragraph rejections are maintained.

It is noted that the removal of "aggregate" claim language from claims 86-126 and 130-137 would have overcome the new matter issue. However, "aggregate" may still be found in claims 127-129, thus the new matter rejection would be maintained for the reasons already of record. Furthermore, the amendments to the claims 86-126 and 130-137 would have overcome the 112 second paragraph rejections. The 112 second paragraph rejections would not have been withdrawn from Claims 127-129 for the reasons already of record.

The additional limitation added to Claims 86- which requires that the triple stranded complex is more thermostable than a triple stranded complex formed from either of two nucleic acid A binding molecules B with one nucleic acid A or two nucleic acid A binding molecules C with one nucleic acid A is an inherent property of the triple stranded molecule. The structure of the claimed triple stranded molecule is the same that described in the art, thus, the thermostability inherently would be more thermostable than the other suggested complexes. The response asserts that Svinarchuk does not involve two binding probes B and C, however, as previously stated the claims do not include specific size requirements from nucleic acid binding probe C and thus a double stranded molecule is encompassed by the claims. Thus, claims which are drawn to a single nucleic acid binding probe C are anticipated by Svinarchuk.

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